REMARKS

The March 9, 2004 Office Action was based upon pending Claims 1-34. This Amendment amends Claims 1, 2, 17, 26, and 34 and cancels Claim 20. Thus, after entry of this Amendment, Claims 1-19 and 21-34 are pending and presented for further consideration.

In the March 9, 2004 Office Action, the Examiner rejected Claims 1-25 and 34 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,289,357 to Parker (the "Parker patent") in view of U.S. Patent No. 6,151,607 to Lomet (the "Lomet patent").

Further, the Examiner rejected Claims 26-33 under 35 U.S.C. §103(a) as being unpatentable over the Lomet patent.

EXAMINER INTERVIEW

Applicant would like to thank the Examiner and his Supervisor for the interview extended to Applicant's counsel of record, John R. King, on June 16, 2004. During the interview, the Examiner agreed that the proposed amendments clarified the patentably distinguishing features of the invention. Thus, applicants have made similar clarifications to the other independent claims.

Reconsideration of the pending claims as clarified is therefore respectfully requested.

REJECTION OF CLAIMS 1-25 AND 34 UNDER 35 U.S.C. § 103

The Examiner rejected Claims 1-25 and 34 under 35 U.S.C. §103(a) as being unpatentable over the Parker patent in view of the Lomet patent.

While a number of differences exist, generally speaking the Parker patent reconciles a source database with a target database; however, Parker does not describe how to reconcile the source and target if the target goes off-line and then needs to be recovered.

Furthermore, the Parker patent does not appear to provide any teaching regarding rolling back of transactions during a recovery operation. Furthermore, the

Parker patent does not appear to provide any teaching regarding purging stale transactions while rolling transaction forward during replication.

While the Lomet patent appears to discuss how to recover an application, Lomet does appear to provide any teaching regarding the rolling back of transactions during a recovery operation. Rather, Lomet appears to teach that an application is recovered to a stable point. Transactions that occurred after the stable point are then applied to the recovered database. There does not appear to be any teaching of rolling back transactions that occurred prior to the stable point.

Furthermore, even if the Parker patent could be combined with the Lomet patent, which it cannot, the combination would not teach applicant's claimed inventions. Neither reference teaches rolling back information during recovery of the target database and then purging of stale transactions when rolling forward during replication.

Section 2143 of the M.P.E.P. states that to establish prima facie obviousness three requirements must be met:

> "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

First, there is no suggestion or motivation to combine the Lomet and Parker patents to obtain a system that both recovers a target system and the reconciles the target system with a source system during replication.

Rather, it appears that the Examiner has impermissibly used hindsight derived from the teachings in the present application, and not the teachings of the prior art, to reject the claims. In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999) (holding the Board impermissibly used hindsight in determining obviousness); See also, M.P.E.P., Sect. 2145, part X.A. In Dembiczak, the Federal Circuit reiterated that a determination of obviousness cannot simply rely on the inventor's disclosure as a "blueprint" without evidence of a suggestion, teaching or motivation in the prior art. Dembiczak, 175 F.3d

994, 999. Also, according to M.P.E.P. Section 706.02(j), "[t]he teaching and suggestion to make the claimed combination and the reasonable expectation for success must both be found in the prior art and not based on applicant's disclosure." (emphasis added).

Second, there must be a reasonable expectation of success. Because neither the Parker patent nor the Lomet patent teach how to resolve inconsistencies that occur when recovering a target database that then receives replication transactions from a source system, there doesn't appear to be any expectation of success that the two systems when combined would address the such problems.

Third, neither the Parker patent nor the Lomet patent teach all the claimed limitations. For example, neither the Parker patent nor the Lomet patent teach rolling back information during recovery of the target database and then purging of stale transactions when rolling forward during replication.

Applicant therefore respectfully submits that independent Claims 1, 2, 17 and 34 are patentably distinguished over the cited references and Applicant respectfully requests allowance of Claims 1, 2, 17 and 34.

Furthermore, Claims 3-16 which depend from Claim 2, dependent Claims 18-25 which depend from Claim 17 are believed to be patentable for the same reasons articulated above with respect to Claims 2 and 17 and because of the additional features recited therein.

Withdrawal of the rejection of Claims 1-25 and 34 under 35 U.S.C. §103(a) is therefore respectfully requested.

REJECTION OF CLAIMS 26-33 UNDER 35 U.S.C. § 103

The Examiner rejected Claims 26-33 under 35 U.S.C. §103(a) as being unpatentable over the Lomet patent.

As discussed above, the Lomet patent does not appear to teach rolling back information during recovery of the target database and then purging of stale transactions when rolling forward during replication.

As discussed above, Applicant respectfully submits that independent Claim 26 is patentably distinguished over the cited references and Applicant respectfully requests allowance of Claim 26.

Furthermore, Claims 27-33 which depend from Claim 26 are believed to be patentable for the same reasons articulated above with respect to Claim 26 and because of the additional features recited therein.

Withdrawal of the rejection of Claims 26-33 under 35 U.S.C. §103(a) is therefore respectfully requested.

CONCLUSION

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of the above remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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